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PTO/SB/21 (09-04)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/082,601
	Filing Date	February 22, 2002
	First Named Inventor	Satoshi Nakajima
	Art Unit	2143
	Examiner Name	Doan, Duyen My
Total Number of Pages in This Submission	Attorney Docket Number	109908-130337

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
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Date	March 28, 2006	Reg. No.	56,826

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By: Yvette L. Chriscaden Date: March 28, 2006  
Yvette L. Chriscaden

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

App. No.	:	10/082,601	Confirmation No.:	5731
Inventor	:	Satoshi Nakajima		
Filed	:	February 22, 2002		
Title	:	AUTONOMOUS RENDERING OF EMAIL ATTACHMENTS		
Art Unit	:	2143		
Examiner	:	Doan, Duyen My		
Customer No.	:	25,943		



MAIL STOP: APPEAL BRIEF-PATENTS  
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**APPELLANT'S BRIEF IN SUPPORT OF APPELLANT'S APPEAL  
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Dear Sir:

This appeal furthers the Notice of Appeal filed on February 27, 2006. The appeal arises from a final decision by the Examiner in the final Office Action, dated November 2, 2005. The final decision was in response to arguments filed on August 8, 2005, in response to an earlier office action, mailed May 12, 2005.

Appellant submits this *Brief on Appeal* in triplicate, including payment in the amount of \$500.00 to cover the fee for filing the *Brief on Appeal*. Appellant respectfully requests

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consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application.

**Real Party in Interest:**

This application is assigned UI Evolution, Inc., having a principal place of business at 11245 SE 6th St., Suite 110, Bellevue, Washington 98004 by virtue of an assignment recorded with the United States Patent and Trademark Office on February 22, 2002, at Reel 012643 Frame 0158.

**Related Appeals and Interferences:**

To the best of Appellant's knowledge, there are no related appeals or interference proceedings currently pending, which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**Status of Claims:**

Appellant appeals the rejection of claims 1-40. Claims 1-40 were pending and claims 1-36 were rejected in the final Office Action dated November 2, 2005. Claims 1-40 are reproduced, as pending, in Appendix A.

**Status of Amendments:**

Appellant has offered no amendments subsequent to the Examiner's final Office Action.

**Summary of the Claimed Subject Matter:**

Independent claim 1 is directed towards *a computer implemented method* that comprises "processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application, and generating by the computing device a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, to enable viewing of said contents of said binary file without usage of

said source application, by rendering said one or more user interface displays in accordance with said one or more specifications.” Element 104 of Figure 1 illustrates one example of an application, email application of an email sender 102, capable of performing the operations recited in claim 1. Element 104 of Figure 1 is described in detail on pages 6-7, in accordance with some embodiments. Figure 2 is a flowchart illustrating selected operations of the example email application performing the operations recited in claim 1. The operations illustrated by Figure 2 are described in greater detail on pages 7-8, in accordance with some embodiments. Figure 3 illustrates an example end user interface capable of facilitating the operations recited by claim 1. The end user interface illustrated by Figure 3 is described in greater detail on pages 9-10, in accordance with some embodiments. Figure 4 illustrates an operational flow for the user interface display generating aspect recited in claim 1. The operational flow illustrated by Figure 4 is described in greater detail on pages 10-11, in accordance with some embodiments.

Independent claim 7 is directed towards *a computer implemented method* reciting similar limitations to independent claim 1. Therefore, support can be found in the same figures and passages in the specification enumerated in the immediately preceding paragraph.

Independent claim 15 is directed towards *a computer implemented method* of operation in an email recipient. Support can be found in the same figures and passages in the specification enumerated in the preceding paragraph summarizing claim 1. Further, support can also be found in Figure 1, where element 114 illustrates an example email application of an email recipient 112 capable of performing the operations recited in claim 15. Element 114 of Figure 1 is described in detail on pages 6-7, in accordance with some embodiments. Figure 2 is a flowchart illustrating selected operations of the example email application performing the operations recited in claim 15. The operations illustrated by Figure 2 are described in greater detail on pages 7-8, in accordance with some embodiments.

Independent claim 21 is directed towards *an apparatus* performing the operations of an example email sender, which, in substance, is claim 1 in apparatus form. Therefore, support can be found in the same figures and passages in the specification enumerated in the preceding paragraph summarizing independent claim 1. Further, additional support can be found in Figure 9 and its corresponding description on pages 15-16. Figure 9 illustrates an apparatus capable of performing the operations of an email sender like the operations recited in claim 1, in accordance with some embodiments.

Independent claim 27 is directed towards *an apparatus* performing the operations of an example email sender, which, in substance, is claim 7 in apparatus form. Therefore, support can be found in the same figures and passages in the specification enumerated in the preceding paragraph summarizing independent claim 7. Further, additional support can be found in Figure 9 and its corresponding description on pages 15-16. Figure 9 illustrates an apparatus capable of performing the operations of the example email sender like the operations recited in claim 7, in accordance with some embodiments.

Independent claim 35 is directed towards *an apparatus* performing the operations of an example email recipient, which, in substance, is claim 15 in apparatus form. Therefore, support can be found in the same figures and passages in the specification enumerated in the preceding paragraph summarizing independent claim 15. Further, additional support can be found in Figure 9 and its corresponding description on pages 15-16. Figure 9 illustrates an apparatus capable of performing the operations of the example email recipient like the operations recited in claim 15, in accordance with some embodiments.

**Grounds For Rejection To Be Argued On Appeal:**

- I. Claims 1-3, 5-15, 18-23, 25-35, and 38-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2002/0059565 to *Reyna et al.* (hereinafter "Reyna") in view of U.S. Patent Publication No. 2002/0046349 to *Burgin et al.* (hereinafter "Burgin").
- II. Claims 4, 16-17, 24, and 36-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reyna and Burgin, as applied to claim 1, and further in view of U.S. Patent No. 6,014,688 to *Venkatraman et al.* (hereinafter "Venkatraman").

**Arguments:**

- I. Rejections of claims 1-3, 5-15, 18-23, 25-35, and 38-40 under 35 U.S.C. §103(a) were improper because Reyna and Burgin, alone or in combination, fail to teach or suggest the claimed invention when the invention as claimed in claims 1-3, 5-15, 18-23, 25-35, and 38-40 is viewed as a whole.

To establish obviousness under 35 U.S.C. § 103, the Examiner must view the invention as a whole. Further, the Examiner is to perform the obviousness analysis in accordance with the standard set forth by the Supreme Court in *Graham v. John Deere Co.* That standard requires that the Examiner (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claims in issue; (3) resolve the level of ordinary skill in the art; and (4) evaluate evidence of secondary considerations. 383 U.S. 1, 17-18 (1966); *see also* MPEP 2141. Secondary considerations include whether the invention met with commercial success, whether the invention answered a long felt need, and whether others attempting the invention have failed. *Graham*, 383 U.S. at 17-18. Further, in applying the *Graham* framework, the Examiner must consider the invention as a whole, without the benefit of hindsight. MPEP 2141.

Claim 1 recites a method comprising:

“processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application; and  
generating by the computing device a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, to enable viewing of said contents of said binary file without usage of said source application, by rendering said one or more user interface displays in accordance with said one or more specifications.”

In contrast, Burgin merely teaches a method of generating a self-contained executable program that can be attached to an email. The executable contains both pictures and instructions to the recipient computer on how to view such pictures, the executable referred to by Burgin as an “album.” However, Burgin’s self-contained executable for viewing the pictures fails to disclose or suggest, expressly or inherently, “one or more specifications correspondingly specifying the one or more user interface displays that would have been rendered if the content is viewed by the source application.” As claimed in claim 1, each user interface display is a display by some source application, if that source application is used to view the content, and each user interface display must have a corresponding specification specifying the end user interface display. No such teaching or suggestion is inherent in Burgin. Burgin is silent on whether the self-contained executable will render the content with the same end user interface displays rendered if the content is viewed by the source “picture” application. Moreover, even if the self-contained representation will render the pictures using the same end-user interface displays rendered by the source “picture” viewing application, the self-contained representation of Burgin may be practiced with one or more “specifications” (but less than the 1:1 correspondence required by claim 1) defining all of the user interface displays to be rendered. Thus, end user interface displays that are the same as those used by a source viewing application, and specifications



correspondingly specifying these user interface displays are neither expressly nor inherently disclosed nor suggested by Burgin.

Reyna does not remedy the deficiencies of Burgin. As the Examiner has noted, Reyna does not teach a self-contained representation, much less a self-contained representation that includes specifications correspondingly specifying user interface displays. Rather, Reyna discloses a method and apparatus for generating an output file that can be used on any sort of computing platform with any sort of user interface, in conjunction with a software application. The output file is generated by compiling a code generation file of a lowest common denominator programming language with a formatted/modified data file expressing data of a raw input data file in some platform independent formatting language such as XML, ASCII, or binary. The only binary file expressly or inherently disclosed by Reyna as being processed is a formatted/modified data file. The raw data file of Reyna is neither expressly nor inherently taught, nor suggested to be a binary file. Further, Reyna does not teach the processing of the formatted/modified data file to identify user interfaces displays. Consequently, Reyna does not disclose or suggest, expressly or inherently, "processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application." Thus, Reyna does not remedy the above discussed deficiencies of Burgin.

Therefore, for at least the foregoing reasons, Reyna and Burgin, individually or in combination, do not suggest claim 1, under 35 U.S.C. §103(a).

Each of independent claims 7, 15, 21, 27, and 35 contains in substance the same recitations earlier discussed for claim 1. Accordingly, for at least the same reasons, claims 7, 15, 21, 27, and 35 are patentable over Reyna and Burgin under 35 U.S.C. §103(a).

Claims 3, 5-6, 8-11, 13-14, 18-19, 23, 25-26, 28-31, 33-34, and 38-39 depend from claims 1, 7, 15, 21, 27, and 35 respectively. Thus, for at least the same reasons, claims 3, 5-6, 8-11, 13-14, 18-19, 23, 25-26, 28-31, 33-34, and 38-39 are patentable over Reyna and Burgin under 35 U.S.C. §103(a).

II. Rejections of claims 4, 16-17, 24, and 36-37 under 35 U.S.C. §103(a) were improper because Reyna, Burgin, and Venkatraman, alone or in combination, fail to teach or suggest the claimed invention when the invention as claimed in claims 4, 16-17, 24, and 36-37 is viewed as a whole.

As stated above, Reyna and Burgin, individually or combined, fail to disclose or suggest the required, recited operations of the present invention, as claimed in claims 1, 15, 21, and 35. Venkatraman does not remedy the above discussed deficiencies of Reyna and Burgin. Thus, even when combined with Venkatraman, the cited art fails to show or suggest the novel features that are noted when the invention of claims 1, 15, 21, and 35 is viewed as a whole.

Claims 4, 16-17, 24, and 36-37 depend from claims 1, 15, 21, and 35. Consequently, claims 4, 16-17, 24, and 36-37 are patentable over the combination of Reyna, Burgin, and Venkatraman, under 35 U.S.C. §103(a).

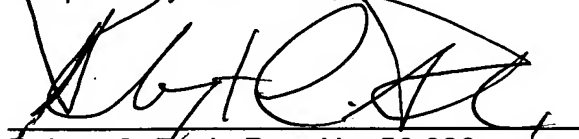
**Conclusion**

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted in triplicate, along with Check Number 13809 for \$500.00 to cover the filing of appeal brief. We do not believe any additional fees, in particular extension of time fees, are needed. However, should that be necessary, please charge our deposit account 500393. In addition, please charge any shortages and credit any overages to Deposit Account No. 500393.

Date: March 28, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. C. Peck', written over a horizontal line.

Robert C. Peck, Reg. No. 56,826  
Agent for Appellant Applicant

Schwabe Williamson & Wyatt, P.C.  
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Seattle, WA 98101  
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## **Appendix A – Appealed Claims**

1. (Previously Presented) A computer implemented method comprising:  
processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application; and  
generating by the computing device a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, to enable viewing of said contents of said binary file without usage of said source application, by rendering said one or more user interface displays in accordance with said one or more specifications.
2. (Previously Presented) The method of claim 1, wherein each specification includes one or more transition rules specifying one or more transitions to one or more other user interface displays specified by one or more other specifications.
3. (Previously Presented) The method of claim 2, wherein each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display state.
4. (Previously Presented) The method of claim 1, further comprising:  
encoding by the computing device an electronic message having said self-contained representation attached, using a MIME protocol, a Uuencode protocol, or a BinHex protocol; and  
transmitting by the computing device said encoded electronic message and self-contained representation to one or more addressed recipients.
5. (Previously Presented) The method of claim 4, further comprising attaching by said computing device said self-contained representation to the electronic message.

6. (Previously Presented) The method of claim 1, wherein each of said user interface displays comprises one or more display cells, and each of said specification comprises one or more display cell specifications correspondingly specifying the one or more display cells.

7. (Previously Presented) A computer implemented method comprising:  
identifying by a computing device a format of a binary file generated by a source application;  
selecting by the computing device a set of user interface display specifications from a plurality of sets of user interface display specifications, based at least in part on the identified format of the binary file; and  
processing by the computing device the binary file to generate a self-contained representation of user interface displays of said binary file rendered when contents of the binary file are viewed using the source application, by associating results of said processing of the binary file with the selected set of user interface display specifications, to enable viewing of the user interface displays without the source application.

8. (Previously Presented) The method of claim 7, further comprising:  
attaching by the computing device said self-contained representation with an electronic message; and  
transmitting by the computing device said electronic message and said attached self-contained representation to one or more recipients for viewing, where the viewing includes rendering said user interface displays in accordance with said user interface display specifications and user input(s).

9. (Previously Presented) The method of claim 7, wherein said binary file is either a word processing document or a spreadsheet document.

10. (Previously Presented) The method of claim 7, wherein said determining is based upon a filename extension associated with said binary file.

11. (Previously Presented) The method of claim 7, wherein said processing further comprises:

launching by the computing device a locally accessible version of the application;

simulating by the computing device user input(s) to said application based at least in part upon said selected set of user interface display specifications; and

storing by the computing device output(s) from said application in response to said user input(s).

12. (Previously Presented) The method of claim 7, wherein each specification includes one or more transition rules specifying one or more transitions to one or more other user interface displays specified by one or more other specifications.

13. (Previously Presented) The method of claim 12, wherein each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display state.

14. (Previously Presented) The method of claim 7, wherein each of said user interface displays comprises one or more display cells, and each of said specification comprises one or more display cell specifications correspondingly specifying the one or more display cells.

15. (Previously Presented) A computer implemented method comprising:  
receiving by a computing device an email message including an associated first attachment of a first attachment type;

determining by the computing device whether said first attachment type is associated with a member of a group of one or more supported source applications;

selecting by the computing device a set of one or more user interface display specifications from a plurality of sets of one or more user interface display specifications, based upon said first attachment type if it is determined said first

attachment type is associated with a member of said group of one or more supported source applications;

launching by the computing device a locally accessible version of the associated source application;

simulating by the computing device one or more user input signals based upon said selected set of one or more user interface display specifications; and

capturing by the computing device output responses of the associated source application to said one or more user input signals, and associating the captured output responses with the selected set of user interface display specifications to generate a self-contained representation of said first attachment to allow subsequent viewing of the attachment without further use of the associated source application.

16. (Previously Presented) The method of claim 15, further comprising:

associating by the computing device said representation with said email message in the form a second attachment, replacing said first attachment;

encoding by the computing device said email message and said second attachment; and

transmitting said encoded email message and second attachment to a designated recipient.

17. (Previously Presented) The method of claim 16, wherein said encoding comprises encoding the representation in accordance with the MIME protocol.

18. (Original) The method of claim 15, wherein said first attachment type comprises a proprietary format.

19. (Previously Presented) The method of claim 15, wherein each of said plurality of user interface displays comprises one or more display cells, and each of said user interface display specifications comprises one or more display cell specifications.

20. (Previously Presented) The method of claim 19, wherein each of said specifications further comprises one or more transition rules, each transition rule specifying a transition to a user interface display when the user interface displays enter a particular display state.

21. (Previously Presented) An apparatus comprising:

a storage medium having stored therein a plurality of programming instructions designed to

process a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application,

generate a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the user interface displays, to enable viewing of said contents of said binary file, without usage of said source application, by rendering said one or more user interface displays in accordance with said one or more specifications; and

at least one processor coupled to the storage medium to execute the programming instructions.

22. (Previously Presented) The apparatus of claim 21, wherein each specification includes one or more transition rules specifying one or more transitions to one or more other user interface displays specified by one or more other specifications.

23. (Previously Presented) The apparatus of claim 22, wherein each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display states.

24. (Previously Presented) The apparatus of claim 21, wherein the programming instructions are further designed to encode an electronic message having said self-



contained representation attached, using either a MIME protocol, a Uuencode protocol, or a BinHex protocol.

25. (Previously Presented) The apparatus of claim 21, wherein the programming instructions are further adapted to attach said self-contained representation to the electronic message.

26. (Previously Presented) The apparatus of claim 21, wherein each of said user interface displays comprises one or more display cells, and each of said specification comprises one or more display cell specifications correspondingly specifying the one or more display cells.

27. (Previously Presented) An apparatus comprising:  
a storage medium having stored therein a plurality of programming instructions designed to  
    identify a format of a binary file generated by a source application;  
    selecting a set of user interface display specifications from a plurality of sets of user interface display specifications, based at least in part on the identified format of the binary file, and  
    processing the binary file to generate a self-contained representation of user interface displays of said binary file rendered when contents of the binary file are viewed using the source application, by associating results of said processing of the binary file with the selected set of user interface display specifications ; and  
at least one processor coupled to the storage medium to execute the programming instructions.

28. (Previously Presented) The apparatus of claim 27, wherein the programming instructions are further designed to  
attach said self-contained representation with an electronic message; and

transmit said electronic message and said attached self-contained representation to one or more recipients for viewing, where the viewing includes rendering said user interface displays in accordance with said user interface display specifications and user inputs.

29. (Previously Presented) The apparatus of claim 27, wherein said binary file is either a word processing document or a spreadsheet document.

30. (Previously Presented) The apparatus of claim 27, wherein said programming instructions are adapted to perform said determining based upon a filename extension associated with said binary file.

31. (Previously Presented) The apparatus of claim 27, wherein the programming instructions are further designed to

launch a locally accessible version of the application;

simulate user input(s) to said application based at least in part upon said selected set of user interface display specifications; and

store output(s) from said application in response to said user input(s).

32. (Previously Presented) The apparatus of claim 27, wherein each specification includes one or more transition rules specifying one or more transitions to one or more other user interface displays specified by one or more other specifications.

33. (Previously Presented) The apparatus of claim 32, wherein each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display states.

34. (Previously Presented) The apparatus of claim 27, wherein each of said user interface displays comprises one or more display cells, and each of said specification comprises one or more display cell specifications correspondingly specifying the one or more display cells.

35. (Previously Presented) An apparatus comprising:  
a storage medium having stored therein a plurality of programming instructions designed to  
receive an email message including an associated first attachment of a first attachment type,  
determine whether said first attachment type is a member of a group of one or more supported source applications,  
selecting a set of one or more specifications from a plurality of sets of one or more user interface display specifications, based upon said first attachment type if it is determined said first attachment type is associated with a member of said group of one or more supported source applications,  
launch a locally accessible version of the associated source application,  
simulate one or more user input signals based upon said selected set of one or more user interface display specifications, and  
capture output responses of the associated source application to said one or more user input signals, and associate the captured output responses with the selected set of user interface display specifications to generate a self-contained representation of said first attachment to allow subsequent viewing of the attachment without further use of the associated source application; and  
at least one processor coupled to the storage medium to execute the programming instructions.

36. (Previously Presented) The apparatus of claim 35, wherein the programming instructions are further designed to  
associate said representation with said email message in the form a second attachment replacing said first attachment;  
encode said email message and said second attachment; and  
transmit said email message and said second attachment to a designated recipient.

37. (Previously Presented) The apparatus of claim 36, wherein said encoding comprises encoding the representation in accordance with the MIME protocol.

38. (Original) The apparatus of claim 35, wherein said first attachment type comprises a proprietary format.

39. (Previously Presented) The apparatus of claim 35, wherein each of said plurality of user interface displays further comprises one or more display cells, and each of said user interface display specifications comprises one or more display cell specifications.

40. (Previously Presented) The apparatus of claim 39, wherein each of said specifications further comprises one or more transition rules, each transition rule specifying a transition to a user interface display when the user interface displays enter a particular display state.

## **Appendix B – Copies of Evidence Submitted**

No evidence has been submitted under 37 C.F.R. 1.130, 1.131, or 1.132. No evidence entered by Examiner has been relied upon by Appellant in the appeal.